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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,708	05/10/2006	Frank Kowalewski	1454.1722	3387
21171	7590	06/10/2009	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CLIFTON, JESSICA L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,708

Applicant(s)

KOWALEWSKI ET AL.

Examiner

JESSICA CLIFTON

Art Unit

2419

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/08/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-11 have been cancelled. Claims 13, 14, 18, 20, 21 have been amended. Claims 12, 15-17, 19 and 22 original.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Donnelly (US Pub. No. 2004/0223605).

As per claim 12, Donnelly discloses **a method for establishment of a communication link from a first telecommunication device to a second telecommunication device via a telecommunication network, comprising** (Abstract, discloses a first communication terminal calling a second communication terminal via a communications service):

sending a connection establishment message (i.e. call set-up) with a data object (i.e. alert descriptor) to the telecommunication network allocated to a first subscriber (i.e. calling terminal) to establish the communication link (Paragraph

[0106], discloses distribution of alert descriptors may occur during call set-up.

Paragraph [0112-3], discloses a call set-up process between two terminals and where a request for call establishment is received. Paragraph [0053], discloses that an alert descriptor is associated with the calling terminal. Figure 1, illustrates terminals (14, 22) connected via a communication network (24));

storing the data object (i.e. alert descriptor) **via the telecommunication network on a data provision component** (i.e. alert management system) (Paragraph [0178], discloses that alert descriptors are stored on an alert server associated with the customized alert management system. Paragraph [0028], discloses that the alert server is network accessible. Figure 1, illustrates network connection between the alert management system and terminals);

transmitting a call signaling message from the telecommunication network to the second telecommunication device (i.e. information received by the called terminal) **providing reference information** (i.e. identity information) **which refers to the data provision component** (i.e. alert management system) **on which the data object** (i.e. alert descriptor) **of the first subscriber** (i.e. calling terminal) **has been stored** (Paragraph [0044], discloses that the alert descriptor is associated with the calling terminal. Paragraph [0189], discloses that the called terminal receives identity information and server location of the alert descriptor from the alert management system via the communications network);

signaling the data provision component (i.e. alert management system) **from the second telecommunication device** (i.e. called terminal) **by using the reference information** (i.e. identity information) **requesting that the data provision component** (i.e. alert management system) **transmit the data object** (i.e. alert descriptor) **to the second telecommunication device** (i.e. called terminal) **allocated to the first subscriber** (i.e. calling terminal) (Paragraph [0189], discloses the that called terminal receives identity information corresponding to the identity and location of the alert descriptor. The called terminal establishes a connection with the alert management system and requests the server to provide the appropriate alert descriptor. Paragraph [0044], discloses that the alert descriptor is associated with the calling terminal);

transmitting the data object (i.e. alert descriptor) **from the data provision component** (i.e. alert management system) **to the second telecommunication device** (i.e. called terminal) (Paragraph [0178], discloses that alert descriptors are stored on an alert server associated with the customized alert management system. Paragraph [0190], discloses a transfer of the alert descriptor from the alert server to the called terminal).

playing (i.e. activating) **the data object** (i.e. alert descriptor) **at the second telecommunication device** (Paragraph [0015], discloses that the second communications terminal activates an alert using the alert descriptor. Paragraph [0046],

discloses that an alert descriptor may be decoded by a terminal in order to play the corresponding alert).

As per claim 13, Donnelly discloses **the method according to claim 12.**

Donnelly further disclose **wherein the telecommunication network has a first subnetwork to which the first telecommunication device** (i.e. calling terminal) **has been allocated and a second subnetwork to which the second telecommunication device** (i.e. called terminal) **has been allocated, the first and second subnetworks being connected with each other via a switching component** (i.e. entity/processing logic) (Paragraph [0196], discloses that calling terminal and the called terminal can be associated with distinct communication networks capable of supporting a connection session between each other. Paragraph [0026], discloses an entity/processing logic associated with a switch which establishes a call. Figure 1, illustrates processing logic connecting the separate terminals via the communication network).

As per claim 14, Donnelly discloses **the method according to claim 13.**

Donnelly further discloses **wherein the switching component** (i.e. entity) **performs said storing and transmitting** (Paragraph [0181], discloses that the entity forwards the alert descriptor identity information to the alert management system. Paragraph [0178], discloses that alert descriptors and identifiers are stored on an alert server associated with the customized alert management system. Figure 1, illustrates a connection between the alert management system, alert server, processing logic and the network).

As per claim 15, Donnelly discloses **the method according to claim 14.**

Donnelly further discloses **wherein the data provision component** (i.e. alert management system) **is arranged on a network based on an Internet protocol and connected to the switching component** (Paragraph [0178], discloses that alert descriptors are stored on an alert server associated with the customized alert management system. Paragraph [0189], disclose that the communication between a terminal and the alert server may take place over an IP network. Figure 1, illustrates a connection between the alert management system, alert server, processing logic and the network).

As per claim 16, Donnelly discloses **the method according to claim 15.**

Donnelly further discloses **wherein the reference information has a uniform resource identifier** (Uniform resource identifier is an identifier of the alert descriptor that can be transmitted to the called terminal. Paragraph [0189], discloses that the called terminal receives identity information corresponding to the identity and location of the alert descriptor).

As per claim 17, Donnelly discloses **the method according to claim 16.**

Donnelly further discloses **wherein the second telecommunication device is in a communication session in accordance with a session initiation protocol** (Paragraph [0031], discloses that a communications terminal may be a SIP phone).

As per claim 18, Donnelly discloses **the method according to claim 17.**

Donnelly further discloses **wherein the switching component (i.e. entity) sends an INVITE message, as the call signaling message, to the second telecommunication device (i.e. called terminal) into which the reference information (i.e. identifier) has been inserted** (Paragraph [0113], discloses an entity sending a call set up request signal to the called terminal. Paragraph [0119], discloses that the entity supplies the called terminal with alert descriptor identifiers. Paragraph [0106], discloses distribution of alert descriptors may occur during call set-up).

As per claim 19, Donnelly discloses **the method according to claim 18.**

Donnelly further discloses **wherein the data object includes picture information, tone information and text information** (Paragraph [0045], discloses that the alert descriptor may encode sounds, images or other forms of multimedia).

As per claim 20, Donnelly discloses **the method according to claim 19.**

Donnelly further discloses **wherein at least one of the first and second telecommunication devices is one of a mobile radio device, a mobile telephone or a computer with a radio module** (Paragraph [0031], discloses that a terminal may be a cellular mobile handset).

As per claim 21, Donnelly discloses **the method according to claim 20**.
Donnelly further discloses **wherein the telecommunication network includes a mobile radio network functioning according to one of a global system for mobile communication standard or a universal mobile telecommunications system standard** (Paragraph [0151], discloses the use of the mobile network GSM).

As per claim 22, Donnelly discloses **a telecommunication system, comprising:**
a telecommunication network (Figure 1, illustrates a communication network);
a data provision component (i.e. alert management system), **connected to said telecommunication network** (Figure 1, illustrates a alert management system connect to a communication network);
and first and second telecommunication devices, said first telecommunication device establishing a communication link to said second telecommunication device via said telecommunication network (Figure 1, illustrates terminals (14, 22) connected via a communication network (24)) **by sending a connection establishment message with a data object to said telecommunication network allocated to a first subscriber to establish the communication link** (Paragraph [0106], discloses distribution of alert descriptors may occur during call set-up.
Paragraph [0112-3], discloses a call set-up process between two terminals and where a

request for call establishment is received. Paragraph [0053], discloses that an alert descriptor is associated with the calling terminal),

said data provision component storing the data object (Paragraph [0178], discloses that alert descriptors are stored on an alert server associated with the customized alert management system),

said telecommunication network transmitting a call signaling message to said second telecommunication device providing reference information which refers to the data provision component on which the data object of the first subscriber has been stored (Paragraph [0044], discloses that the alert descriptor is associated with the calling terminal. Paragraph [0189], discloses that the called terminal receives identity information and server location of the alert descriptor from the alert management system via the communications network),

said second telecommunication device signaling said data provision component using the reference information, to request that said data provision component transmit the data object to said second telecommunication device allocated to the first subscriber (Paragraph [0189], discloses the that called terminal receives identity information corresponding to the identity and location of the alert descriptor. The called terminal establishes a connection with the alert management system and requests the

server to provide the appropriate alert descriptor. Paragraph [0044], discloses that the alert descriptor is associated with the calling terminal),

said data provision component transmitting the data object to said second telecommunication device and said second telecommunication device playing the data object (Paragraph [0104] playing the alert, Paragraph [0178], discloses that alert descriptors are stored on an alert server associated with the customized alert management system. Paragraph [0190], discloses a transfer of the alert descriptor from the alert server to the called terminal).

Response to Arguments

3. Applicant's arguments filed 02/08/2009 have been fully considered but they are not persuasive.

- Applicant argues that Donnelly teaches storing a data object (i.e. alert descriptor) are previously stored and therefore does not teach the following limitation:
sending a connection establishment message with a data object to the telecommunication network allocated to a first subscriber to establish the communication link; storing the data object via the telecommunication network on a data provision component

The claim language does not specify when the storing of the data object occurs, therefore the claim was broadly interpreted to include storing the data object (i.e. alert descriptor) prior to establishment message (i.e. call set-up) as taught by Donnelly,

Paragraph [0106]. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, Donnelly, Paragraph [0106], does teach the argued limitation.

- Applicant argues that Donnelly does not teach that the data object has been sent from the calling party and therefore does not teach the following limitation:
transmitting a call signaling message from the telecommunication network to the second telecommunication device providing reference information which refers to the data provision component on which the data object of the first subscriber has been stored

The claim language does not specify that the data object is sent from the first subscriber (i.e. calling terminal). The claim language states “...**the data object of the first subscriber...**” which is broadly interpreted to include a data object (i.e. alert descriptor) which is associated with the first subscriber, as taught by Donnelly, Paragraph [0110]. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, Donnelly, Paragraphs [0187-0188], which refer to the data object, does teach the argued limitation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JESSICA CLIFTON** whose telephone number is (571)270-7156. The examiner can normally be reached on Monday-Friday, 8:00 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patel, Jay can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JESSICA CLIFTON/
Examiner, Art Unit 2419

/Alpus H. Hsu/
Primary Examiner, Art Unit 2419